

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMERICAN ACADEMY OF SCIENCE

Appeal No. 1998-1483
Application 90/003,463¹

REHEARING

Before KRASS, JERRY SMITH and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant filed a paper titled "REQUEST FOR REHEARING" on July 9, 1999. The request for rehearing asks that we reconsider that portion of our decision on rehearing dated March 9, 1999 wherein we sustained the rejection of claims under 35 U.S.C. § 103. More specifically, appellant requests that we designate

¹ Reexamination proceeding for U.S. Patent No. 4,714,989, issued December 22, 1987, filed June 7, 1994.

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our affirmance of the rejections under 35 U.S.C. § 103 as new grounds of rejection.

We note that appellant has also simultaneously filed an amendment and a declaration under 37 CFR § 1.132 with the request for rehearing. These papers will need to be considered by the examiner and are not before us at this time. We decide the request for rehearing first so that continued prosecution before the examiner can properly include all legitimate issues.

A brief review of the history of prosecution in this reexamination is necessary. The examiner made rejections of the claims under 35 U.S.C. §§ 102/103 as anticipated by the applied prior art or obvious in view of the applied prior art. We affirmed the rejections under 35 U.S.C. § 102 based upon a different interpretation of the claim language [decision mailed August 24, 1998]. We also affirmed the rejections under 35 U.S.C. § 103 on the basis that anticipation was the epitome of obviousness. Appellant requested rehearing of this decision and argued that the affirmance of the rejection under 35 U.S.C. § 102 should be designated a new ground of rejection based on the different claim interpretation used by the Board. We granted this request and designated the rejection under 35 U.S.C. § 102 as a new ground of rejection [decision on rehearing dated March 9, 1999]. In that same decision, we also indicated that our

blanket affirmance under 35 U.S.C. § 103 was incomplete and that we should have considered the rejections under 35 U.S.C. § 103 separately on the merits. We then affirmed the rejections of the claims under 35 U.S.C. § 103 on the merits based on the claim limitations and the teachings of the applied prior art [id.]. Appellant now asks that we designate the affirmance of these rejections under 35 U.S.C. § 103 as new grounds of rejection.

Although appellant was aware that the examiner's rejection was alternatively made under 35 U.S.C. §§ 102/103, we agree with appellant that the course of prosecution in this proceeding has essentially deprived appellant of a fair opportunity to respond to the question of obviousness. Since the examiner's initial interpretation of the claims was held to be improper by us, appellant has not had a fair opportunity to argue the issues with respect to our claim interpretation nor has the examiner had to consider the claimed invention as interpreted by us. We agree with appellant that simple fairness requires that we allow appellant the opportunity to prosecute before the examiner the invention as interpreted by us.

In summary, we have granted appellant's request for rehearing, and we hereby designate the affirmed rejections under

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35 U.S.C. § 103 in the previous decision on rehearing as new grounds of rejection. This proceeding is remanded to the examiner for consideration of the amendment and declaration filed on July 9, 1999 and any other papers which are properly before the examiner as a result of this decision or our previous decision on rehearing mailed March 9, 1999.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

GRANTED AND REMANDED

Errol A. Krass)	
Administrative Patent Judge)	
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Jerry Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Lee E. Barrett)	
Administrative Patent Judge)	

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